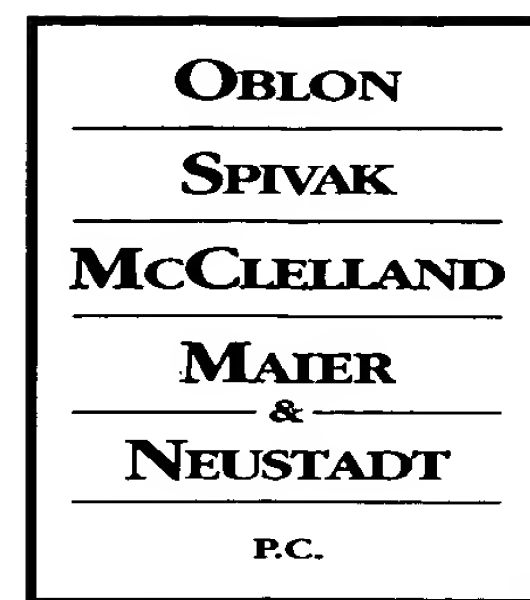




Docket No.: 201225US0

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RE: Application Serial No.: 09/748,261

Applicants: Minoru TAKAYA, et al.

Filing Date: December 27, 2000

For: COMPOSITE DIELECTRIC MATERIAL,
COMPOSITE DIELECTRIC SUBSTRATE, PREPREG,
COATED METAL FOIL, MOLDED SHEET,
COMPOSITE MAGNETIC SUBSTRATE,
SUBSTRATE, DOUBLE SIDE METAL FOIL-CLAD
SUBSTRATE, FLAME RETARDANT SUBSTRATE,
POLYVINYL BENZYL ETHER...

Group Art Unit: 1714

Examiner: CAIN, E.

SIR:

Attached hereto for filing are the following papers:

Response to Restriction Requirement

Our check in the amount of _____ is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Jane M. Terry
Norman F. Oblon

Registration No. 24,618

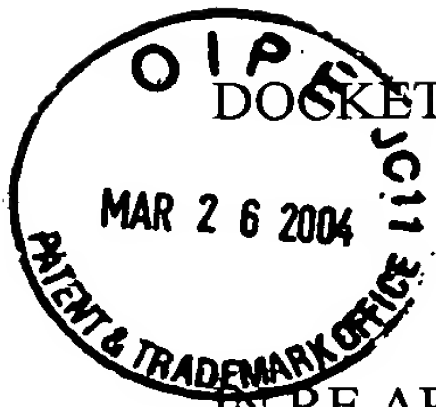
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Jane M. Terry

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DOCKET NO: 201225US0

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

:

MINORU TAKAYA, ET AL.

: EXAMINER: CAIN, E.

SERIAL NO: 09/748,261

:

FILED: DECEMBER 27, 2000

: GROUP ART UNIT: 1714

FOR: COMPOSITE DIELECTRIC
MATERIAL, COMPOSITE DIELECTRIC
SUBSTRATE, PREPREG, COATED
METAL FOIL, MOLDED SHEET,
COMPOSITE MAGNETIC SUBSTRATE,
SUBSTRATE, DOUBLE SIDE METAL
FOIL-CLAD SUBSTRATE, FLAME
RETARDANT SUBSTRATE,
POLYVINYL BENZYL ETHER...

:

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction Requirement mailed February 26, 2004, Applicants elect, with traverse, **Group III (Claims 19-25, 27, 31-33, 40-43, 45-47, 53-60 and 79-86)** for further prosecution in the above-identified application.

The office has required restriction of original claims 1-86 into the following groups.

- I. Claims 1-13, 26, 28-30, 34-38, 44, 48-51, 61-65 and 72-78, drawn to polymer compositions.
- II. Claims 14-18, 39 and 52 drawn to polymer impregnated cloth.
- III. Claims 19-25, 27, 31-33, 40-43, 45-47, 53-60 and 79-86, drawn to laminates.
- IV. Claims 66-71, drawn to polymers.

Applicants elect, with traverse, Group III (Claims 19-25, 27, 31-33, 40-43, 45-47, 53-60 and 79-86) for further prosecution.

The Examiner has asserted that inventions 1-IV are distinct since intermediary products are useful for the preparation of other products, as stated in the present Office Action on pages 2-4. Thus, the Examiner required restriction among Groups I-IV. Applicants respectfully traverse, based on the following reasons.

Applicants submit that the Office has not made a proper restriction. Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. There also must be a serious burden on the Examiner if restriction is required. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion in support of restriction (see MPEP § 803). Applicants respectfully submit that the Office has not demonstrated that it would be a serious burden to examine the entire application.

The Examiner has provided only a generalization that the intermediary products can be used to make other final products. For example, the Examiner asserted that restriction between Groups I, II and III is proper, since the intermediate product is deemed useful as a non-laminated, non-cloth reinforced molding composition, without providing any reasons or examples, in terms of resins, apparatus and procedures, in support of this statement. Similarly, the Examiner has made general statements to support restriction between Groups IV, I, II and III, and Groups II and IV, as noted on page 3 of the present Office Action. These

statements were not supported by reasons or examples, in terms of resins, apparatus and procedures. In addition, the Examiner has failed to provide a specific application for the intermediate product in the restriction of Groups IV, I, II and II. Therefore, the office has not supported its conclusion of restriction of the respective groups, and has not shown that it would be a serious burden to search and examine these groups together.

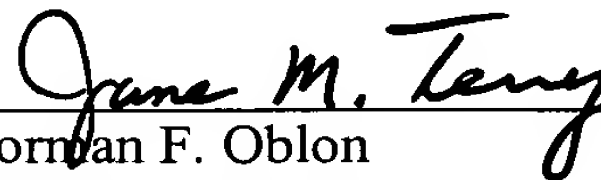
Applicants also submit that if product claims are allowable, process claims directed to the preparation or use of the respective product should be rejoined under MPEP § 821.04, if the process claims depend on, or include all the limitations of, the product claims.

Accordingly, for at least the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary, in order to sustain the requirement for restriction in the present application. Applicants respectfully request the withdrawal of the Restriction Requirement.

Applicants respectfully submit that the present application is now in condition for examination on the merits, and early notice of such action is earnestly requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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